

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS D. JAMIOLKOWSKI, LESLIE HAMILTON,
RICHARD SMITH, AND ROBERT F. BENCINI

Appeal No. 1999-0076
Application No. 08/348,699

ON BRIEF

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 through 7 and 9, as amended subsequent to the final rejection. Claims 8 and 10, the only other claims in the application, stand withdrawn, pursuant to 37 CFR § 1.142(b), as being based upon a nonelected invention.

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Appellants' disclosed invention pertains to a surgical device. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 7, and 9, copies of which appear in the appendix to the brief (Paper No. 14).

As evidence of obviousness, the examiner has applied the documents listed below:

Glick et al 1977 (Glick)	4,008,303	Feb. 15,
Korthoff 1985	4,534,352	Aug. 13,

The following rejection is before us for review.

Claims 1 through 7 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Korthoff in view of Glick.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 15), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 14 and 16).

In the main brief (page 3), appellants expressly indicate that claims 1 through 7 and 9, stand or fall together. In light of the above, we select independent claim 1 for review, as per 37 CFR § 1.192(c)(7). Accordingly, claims 2 through 7 and 9 shall stand or fall with claim 1. It is noted that independent claims 1, 7, and 9 each address contrasting colors for latching and retaining members of a surgical device.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,¹ the applied teachings,²

¹ In claim 9, line 2, "An" should apparently be --an--.

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

(continued...)

and the respective viewpoints of appellants and the examiner.
As a consequence of our review, we make the determinations
which follow.

We reverse the examiner's rejection of claims 1 through 7
and 9.

Claim 1 is drawn to a surgical device having a latching
mechanism comprising, inter alia, a portion of a latching
member and a portion of a retaining member being of
contrasting colors so that the latching member's presence in a
locked position is externally visible.

Like the examiner (answer, page 4), we find that the
patent to Korthoff teaches a surgical device having a latching
mechanism wherein a latching member is received and retained
within the apertures of a retaining member, but the patent
fails to disclose latching and retaining members of
contrasting colors.

²(...continued)

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As to the Glick patent, we find that it addresses a surgical element, such as a suture, a staple, a pad, a bandage, and a sponge (column 8, lines 20 through 66), which is formed of a material (polyglycolic acid or PGA) to give it a color such that the surgical element is more easily seen by a surgeon in contrast with blood and tissue or bandages or other background materials. When a biocomponent structure is used (column 7, line 53 to column 8, line 8), if an absorbable PGA element is colored green

and a permanent reinforcing element is colorless or white, the surgeon is more rapidly able to ascertain which element is permanent.

In our opinion, one having ordinary skill in the art, from a combined consideration of the applied teachings, would have been motivated to use a PGA material for fabricating the surgical fastener of Korthoff (Fig. 2). However, in this instance, each of the fastener member and retainer member would be given the same color so that the surgical fastener would be visible to a surgeon against contrasting backgrounds, following the teaching of Glick. This is not the contrasting color arrangement between portions of the latching member and the retaining member of a surgical device, as required by independent claim 1, as well as by independent claims 7 and 9. As we see it, only reliance upon appellants' own teaching and impermissible hindsight would have enabled one having ordinary skill to derive the claimed invention from the applied prior art. Since the evidence of obviousness before us would not have been suggestive of the claimed invention, the rejection under 35 U.S.C. § 103 must be reversed.

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REMAND

We remand this application to the examiner to consider the following matter.

The prior art relevant to an obviousness determination encompasses not only the particular field of an inventor's endeavor but also any analogous arts. See Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1071, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994). The test of whether a reference is from a nonanalogous art is first, whether it is within the field of the inventor's endeavor, and second, if it is not, whether it is reasonably pertinent to the particular problem with which the inventor was involved. See In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

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Based upon the claimed invention and the problem addressed by appellants, it appears to us to be appropriate for the examiner to consider relevant subclasses in the latching (locking) mechanism arts in assessing whether teachings therein would be reasonably pertinent to the appellants' problem, i.e., the problem of ascertaining whether a latching member has locked into a retaining member; solved by the members having contrasting colors so that when locked in place the latching member's presence in the locked position is visible.

In summary, this panel of the board has reversed the rejection of appellants' claims on appeal. We have also remanded the application to the examiner for the reason explained above.

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The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

ICC/sld

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Application No. 08/348,699

AUDLEY A. CIAMPORCERO, JR.
ONE JOHNSON AND JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

COHEN

APPEAL NO. 1999-0076 - JUDGE

APPLICATION NO. 08/348,699

APJ COHEN

APJ FRANKFORT

APJ McQUADE

DECISION:

Prepared By:

DRAFT TYPED: 30 Apr 01

FINAL TYPED: